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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/406,320	09/27/1999	GUIDO M. SCHUSTER	99.373	1480

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EXAMINER

HOOSAIN, ALLAN

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/406,320

Applicant(s)

SCHUSTER ET AL.

Examiner

Allan Hoosain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6, 14-16, 18-23, 41-47 and 51-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 54-57 is/are allowed.
- 6) ☒ Claim(s) 1-3, 14-16, 18-23, 41-47 and 51-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 27. 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. Claims 54-57 are allowed.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-2, 14-16, 18-23, 41-43, 45-47, and 51-53 are rejected under 35 U.S.C. 102(e) as being anticipated by **Kelly** (US 5,999,965).

As to Claims 1, 16, 18, with respect to Figures 4-5, **Kelly** teaches a system for providing advertising on a data network telephony system comprising:

a data network to provide data connectivity for a plurality of data communications channels using data transport protocols (Figure 4, label 440 and 1-16);

a commercial message server, 400, being operable to send at least one commercial message (Figure 5, Col. 12, lines 14-25 and Col. 16, lines 25-30);

a first, 420, and second, 430, data network telephone connected to the data network, each data network telephone operable to communicate voice signals as data packets on a voice over

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data channel, the voice over data channel being one of the plurality of data communications channels on the data network containing packetized voice signals, the data network telephones identified by a caller (first) and agent (second) user identifier corresponding to the data network telephones (Figure 4);

a network telephony connection server, 410, being operable to provide telephony service to the data network telephones and communicate at least one Sales @ company. Com (commercial message) request with the commercial message server (Col. 15, lines 1-25 and 64 through Col. 16, line 5); and

the first data network telephone being operable to receive the ^{downloaded} commercial messages before the first and second data network telephones communicate voice signals on the voice over data channel (Col. 16 lines 21-32),

the first data network telephone further comprising a message display device to display the commercial messages (Col. 16, lines 25-30 and Col. 16, lines 49-56).

As to Claim 2, **Kelly** teaches the system of Claim 1 wherein:

each user identifier that includes a unique sequence of alphanumeric elements (Col. 15, lines 17-19 and Col. 8, lines 8-11).

As to Claim 14, **Kelly** teaches the system of claim 1 wherein the network telephony connection server further comprises:

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a group organization service (an advertisement service) to retrieve a sales @ company. com message (at least one commercial message from the commercial message server) and to communicate the commercial messages in the response message (Col. 16, lines 1-8).

As to Claim 15, **Kelly** teaches the system of claim 1, wherein the network telephony connection server further comprises:

an advertisement service to send a connection information message to the commercial message server (Col. 16, lines 9-15);

wherein the communication message server uses the connection information message to initiate a selected data communications channel and to send at least one of the commercial messages to the first data network telephone over the selected data communications channel (Col. 16, lines 25-29).

As to Claim 19, **Kelly** teaches the system of claim 1 wherein:

the request message includes a callee user identifier (Col. 15, line 64 through Col. 16, line 4); and

wherein the network telephony connection server determines the telephony identifier for the callee identified in the callee user identifier and sends the response message to the callee at the telephone identifier (Col. 16, lines 8-15).

As to Claims 20,22-23, with respect to Figures 4-5, **Kelly** teaches a method for advertising on a telephony system, the method comprising the steps of:

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receiving a request to initiate a telephone call between a first data network telephone, 420, to a second data network telephone, 430, over a data network, 440, the first and second data network telephones having a display screen, the request containing a caller user identifier to identify a caller (first user) of the first data network telephone, and an agent (callee user identifier) to identify a user of the second data network telephone (Figure 4, Col. 15, lines 17-19 and Col. 8, lines 8-11));

communicating a commercial message request to a commercial message server, 500, *computer merchants and retailers* (Figure 5 and Col. 16, lines 5-8);

retrieving at least one commercial message from a commercial message server (Col. 16, lines 21-29);

sending the at least one commercial message to the first data network telephone (Col. 16, lines 25-29); and

receiving the at least one commercial message at the first data network telephone before completing the telephone call between the first data network telephone and the second data network telephone (Col. 16, lines 21-25 and 49-54).

As to Claim 21, **Kelly** teaches the method of Claim 20 further comprising the steps of:

sending at least one commercial message to the second data network telephone (Col. 17, lines 1-4)

As to Claims 41,45, with respect to Figures 4-5, **Kelly** teaches a commercial message server comprising:

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at least one commercial message for display on a voice communications device (Col. 15, lines 1-11);

a telephony server interface to receive connection information from a telephony connection server, the connection information comprising at least one caller (user identifier) for at least one party to a telephone call (Col. 15, lines 12-25 and Col. 16, lines 8-15),

the at least one party using the voice communications device to initiate the telephone call (Col. 15, lines 60-64);

advertiser's merchant advertisement
the commercial message server, 500, being operable to send the commercial message to the voice communications device in use by the at least one party identified by the user identifier prior to communicating voice signals to the voice communications device (Col. 15, lines 1-11 and Col. 16, lines 1-4).

As to Claims 42-43, **Kelly** teaches the commercial message server of Claim 41 wherein the ACD server (commercial message server) is operable to send the commercial message to the user identifier by sending the commercial message to the telephony connection server (Col. 15, lines 1-11).

As to Claim 46, **Kelly** teaches the commercial message server of Claim 45 wherein the commercial message database includes merchant account information to maintain commercial messages and billing information for merchants (Col. 23, lines 30-40).

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As to Claims 47,51-52, with respect to Figures 4-5, **Kelley** teaches a telephony connection server comprising:

a call management function operable to receive a connectreq (request) to initiate a telephone call using at least one voice communications device, and to send a response message in response to the request message (Col. 15, line 54 through Col. 16, line 4);

a network telephony user database to store a user identifier for each of a plurality of users, wherein the user identifier includes a first sequence of alphanumeric elements that identify a user of a voice communications device (Col. 15, lines 12-42); and

group organization services (an advertisement service) to retrieve a Sales @ company. Com (at least one commercial message) from ACD server 500 (a commercial message server) and to communicate the commercial messages in the response message (Col. 16, lines 1-4).

*confirms a
different
merchant
advertisement*

As to Claim 53, with respect to Figures 4-5, **Kelly** teaches a memory for storing commercial messages comprising:

a group organization reference (merchant record) for identifying a company (merchant) corresponding to the commercial messages (Col. 15, lines 1-10 and Col. 16, lines 1-5); and

a connection to a data network to transport the commercial messages to a plurality of voice communications devices while the plurality of voice communication devices upon receiving connection information for the voice communications devices (Col. 16, lines 1-4 and Figure 5).

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4. Claims 1,20,41,47 and 51-53 are rejected under 35 U.S.C. 102(e) as being anticipated by **Bateman et al.** (US 5,884,032).

As to Claims 1,20,41,47,51-53, with respect to Figures 1-2, **Bateman** teaches a system for providing advertising on a data network telephony system comprising:

a data network to provide data connectivity for a plurality of data communications channels using data transport protocols (Figure 1, label 6 and Col. 6, line 66 through Col. 7, line 13);

a commercial message server, 28, being operable to send an download HTML page (at least one commercial message) (Col. 6, lines 1-8);

a first, 2, and second, 12, data network telephone connected to the data network, each data network telephone operable to communicate voice signals as data packets on a voice over data channel, the voice over data channel being one of the plurality of data communications channels on the data network containing packetized voice signals, the data network telephones identified by a caller (first) and agent (second) user identifier corresponding to the data network telephones (Figure 1 and Col. 6, line 66 through Col. 7, line 13);

a network telephony connection server, 46, being operable to provide telephony service to the data network telephones and communicate a help request (at least one commercial message) request with the commercial message server (Col. 6, lines 25-41); and

the first data network telephone being operable to receive the commercial messages before the first and second data network telephones communicate voice signals on the voice over data channel (Col. 6 lines 25-28),

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the first data network telephone further comprising a message display device to display the commercial messages (Col. 6, lines 55-60).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 3,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kelly** in view of **Giordano, III et al.** (US 6,285,364) and further in view of **Sonesh et al.** (US 6,046,762).

As to Claims 3,6, **Kelly** teaches the system of Claim 2 wherein the first data network telephone further comprises:

Kelly does not teach the following limitation:

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“at least one speed dial key operable to initiate a second voice over data channel to a called party at a selected voice communications device when the speed dial key is assigned to the called party's user identifier”

Sonesh teaches a caller connecting to a second channel while waiting in queue in order to occupy a caller's waiting time (Col. 6, lines 62-67). **Giordano, III** teaches speed dial keys (Figure 2 and Col. 5, lines 30-38). **Kelly** teaches placing a caller in a queue and sending advertisements, etc. to occupy the caller's waiting time (Col. 16, lines 29-32). Therefore, having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add speed dial key and second connection capabilities to **Kelly's** invention for connecting callers to a second connection as taught by **Giordano, III's** and **Sonesh's** inventions in order to provide callers with useful information quickly whilst waiting in queues.

8. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Kelly** in view of **Oran** (US 6,275,574).

As to Claim 44, **Kelly** teaches the commercial message server of Claim 43:

Kelly does not teach the following information:

“wherein the data communications channel uses the RTP protocol to transport the commercial message”

Oran teaches the limitation (Col. 8, lines 40-46). Having the cited art at the time the invention was made, it would have been obvious to one of ordinary skill in the art to add RTP

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capability to **Kelly's** invention for voice communications as taught by **Oran's** invention in order to provide real-time voice communications over data networks.

Response to Arguments

9. Applicant's arguments with respect to claims 1-2,3,6,14-16,18-23,41-47 and 51-53 have been considered but are moot in view of the new ground(s) of rejection and the following:

(a) Claims 24-25 were deleted on Page 1 of the 4/30/03 amendment. Page 6 of the amendment indicates that the claims are pending. Similarly, Claim 19 appears to be deleted and pending. For this office action, Examiner has assumed that Claims 24-25 were deleted and Claim 19 is pending.

(b) Examiner respectfully invites Applicants to contact Examiner to discuss possible amendments for overcoming the prior art of record.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Busey et al. (US 6,377,944) teach a web server which provides customers with commercial information.

Cave (US 5,958,014) teaches an information server that provides information to callers and connection to agents.

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11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231
or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

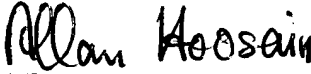
(703) 306-0377 (for customer service assistance)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Allan Hoosain** whose telephone number is (703) 305-4012. The examiner can normally be reached on Monday to Friday from 7 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Fan Tsang**, can be reached on (703) 305-4895.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.


Allan Hoosain
Primary Examiner
7/24/03